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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,555	03/30/2004	Vihar C. Surti	10000/125	6408

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EXAMINER

KOHARSKI, CHRISTOPHER

ART UNIT PAPER NUMBER

3763

DATE MAILED: 12/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/802,555

Applicant(s)

Surti, Vihar C.

Examiner

Christopher D. Koharski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

Examiner acknowledges the filed RCE on 11/15/2006 that includes entered amended claims 1, 3, 5 and 18. Currently claims 1-18 are pending for examination in this application.

### ***Response to Arguments***

Applicant's arguments filed 11/15/2006 have been fully considered but they are not persuasive. Regarding claims 1-18 (under the Kane et al. reference, (6,985, 776), Applicant's representative asserts that the amended claim limitation containing magnets that are configured to abut an interior surface and are configured to approximate a force to the interior body overcome the prior art of record. Examiner disagrees with this assertion, Examiner asserts that the additional claim limitations are functional language with no associated structure; and therefore where the prior art reference is inherently capable of performing the function described in a functional limitation, such functional limitation does not define the claimed apparatus over such prior art reference, regardless of whether the prior art reference explicitly discusses such capacity for performing the recited function, see *In re Ludtke*, 441 F.2d 660, 169 USPQ 563 (CCPA 1971). The Kane et al. reference is disclosed being used in the body and therefore is inherently capable of being used in other places in the body and the magnetic forces produced by the magnetic catheter tips are capable of creating an approximating force, Examiner suggests the following subject matter to overcome the prior art of record (see below).

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***Suggested Allowable Subject Matter***

The following claim subject matter is suggested by the examiner and considered to distinguish patentably over the art of record in this application and is therefore presented to Applicant for consideration:

Examiner recommends either a method claim to support Applicant's intended invention or with claim 18 as a basis, adding additional claim limitations drawn to Applicant's specification [0027] including elements (26, 32) and the linking structure between catheters (38, 44).

***Specification***

The disclosure is objected to because of the following informalities: Upon further examination of the disclosure Examiner cannot find reference to drawing elements (26, 32). Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-6, and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Kane et al. (6,985,776). Kane et al. discloses a method and apparatus for cannulation.

Regarding claims 1, 3, and 5, Kane et al. discloses a device that has an elongate first and second member that contains a magnet (Figures 3, 6) that can either be energized or can be a permanent earth magnet (col 4-5) which would display a constant magnetic force that is capable of approximating a force to the interior of the body. Additionally, the device is capable of being placed into a variety of body areas such as the upper and lower esophageal sac and abutting the interior surface thereof.

Regarding claims 2, 4, 6 and 10, Kane et al. discloses a device that has an upper and lower magnet that are configured to meet (Figure 7) with the elongate member containing a passageway with a flexible member connected to the magnet.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 7-8 are rejected under 35 U.S.C 103(a) as being unpatentable over Kane et al. in view of Rudie (3,771,526). Kane et al. meets the claim limitations as described above but does not include magnets shaped in the claim limitations.

However, Rudie teaches an anastomosis clamp. Regarding claims 7-8, the reference teaches the use of an anastomosis clamp system wherein the two engaging means are shaped in multiple ways to engage themselves (Figures 5 and 11).

At the time of the invention, it would have been obvious to use the shaped engaging means of Rudie with the magnet system of Kane et al. The addition of the surface modified tissue engaging regions provides a unique surface to meet and connect the tissues. Both references are analogous in the art and with the instant invention; therefore, a combination is proper. Therefore, one skilled in the art would have combined the teachings in the references in light of the disclosure of Rudie.

#### ***Claim Rejections - 35 USC § 103***

Claims 9, 11-14, and 18 are rejected under 35 U.S.C 103(a) as being unpatentable over Kane et al. in view of Anderson (4,244,362). Kane et al. meets the

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claim limitations as described above but does not include a balloon member and operative lumen.

However, Anderson teaches an endo-tracheal magnetic control device.

Regarding claims 9, 11-14, and 18, Anderson teaches a catheter device that has a magnetic component that incorporates a balloon (17) assembly (Figures 1, 5) with an operative lumen and multiple flexible member lumens.

At the time of the invention, it would have been obvious to use the balloon assembly of Anderson with the system of Kane et al. because the addition of a balloon allows the catheter to be secured during the procedure. Both references are analogous in the art and with the instant invention; therefore, a combination is proper. Therefore, one skilled in the art would have combined the teachings in the references in light of the disclosure of Anderson.

### ***Claim Rejections - 35 USC § 103***

Claims 15-16 is rejected under 35 U.S.C 103(a) as being unpatentable over Kane et al. in view of Mager et al. (2003/0130610). Kane et al. meets the claim limitations as described above but does not include the gastric catheter with a plurality of ports.

Regarding claims 15-16, Mager et al. teaches catheter with a plurality of ports (106).

At the time of the invention, it would have been obvious to use the ports of Mager et al. with the catheter system of Kane et al. The addition of the multiple ports allows for the use of these ports for fluid removal or introduction of therapeutic drugs, or feeding

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liquids. Both references are analogous in the art and with the instant invention; therefore, a combination is proper. Therefore, one skilled in the art would have combined the teachings in the references in light of the disclosure of Mager et al.

### ***Claim Rejections - 35 USC § 103***

Claim 17 is rejected under 35 U.S.C 103(a) as being unpatentable over Kane et al. in view of Auzin et al. (2,308,484). Kane et al. meets the claim limitations as described above but does not include the distal element being secured by a band.

However, Auzin et al. teaches a general use inflatable catheter. Regarding claim 17, the reference teaches the use of band placed on the balloon to additional secure the balloon end and reinforces the assembly elements (Figure 6).

At the time of the invention, it would have been obvious to use the band assembly of Auzin et al. with the magnetic elements of Kane et al. The addition of the band attachment provides an easy method of construction and allows for the removal of the end distal elements. Both references are analogous in the art and with the instant invention; therefore, a combination is proper. Therefore, one skilled in the art would have combined the teachings in the references in light of the disclosure of Auzin et al.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D. Koharski whose telephone number is 571-272-7230. The examiner can normally be reached on 7:30am to 4:00pm EST.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Date:

12/06/2006



Christopher D. Koharski  
AU 3763

